

III. REMARKS

The Applicant respectfully requests withdrawal of the finality of the Restriction requirement. As noted in Applicant's prior response, the Restriction made in the first Action (mailed July 15, 2003) in this application, was defective at least because the Examiner failed to provide reasons to support the conclusion that a Restriction was duly required. M.P.E.P. Sect. 803 states that there are two criteria for a proper requirement for restriction between "patentably distinct species" (underline added). (The two criteria are that (1) the inventions must be independent or distinct as claimed, and (2) there must be a serious burden on the examiner if the restriction is not required). Sect. 803 further states that "examiners must provide reasons and/or examples to support conclusions...", and that "applicable criteria for distinctness must be demonstrated to support a restriction requirement" (the bare statement that the species are patentably distinct does not by itself demonstrate that the claimed species are patentably distinct). Thus, the M.P.E.P. requires that the reasons supporting the conclusions for making a Restriction be provided regardless of whether the claimed inventions are deemed independent inventions or distinct species of the same invention. Regardless of whether the Examiner concludes that the inventions as claimed are independent or distinct and makes the restriction requirement, the conclusory statement alone, that patentably distinct species are claimed and a restriction is required, is not enough to provide the reasons supporting the examiner's conclusion as required by the M.P.E.P. The first Action in this case stated that patentably distinct species are claimed and a Restriction is required, but simply failed to provide any reasons behind that conclusion. The Applicant will not incur the cost of possibly

having to file a divisional application and maintaining the patent that issues therefrom based on a defective Restriction requirement.

The current Action does provide the reasons supporting the Examiners conclusions that distinct species are claimed (the Applicant's statement should not to be considered as an affirmation that the stated reasons are valid or invalid). This, however, is the first time that the Examiner has provided the reasons for the Restriction, and the Applicant should be given the opportunity to respond directly thereto. Accordingly, making the Restriction final in this action is not proper and the finality of the restriction should be withdrawn. It is noted, that Claims 1, 4, 6, 9-10, and 13-16 now read on Figs. 1-3. Claims 2-3, 5, 8 read on the embodiment shown in Figs. 1-2.

The amendment to the claims, deleting features previously recited in the claims is not a narrowing amendment. Claim 2 has been rewritten in independent form incorporating the features of the base claim (Claim 1), and this amendment is also not a narrowing amendment.

The Examiner objected to the Drawings. Claim 1 recites that the storage room is adapted for holding a multiple number of the boxes accommodated in row and/or column arrangement. Figs. 1-3 clearly show the storage room as adapted for holding a multiple number of boxes accommodated in row and/or column arrangement as called for in claim 1. Clearly the storage room shown in Figs. 1-3 can hold a multiple number of boxes in row and/or column arrangement as is otherwise claimed. The objection should be withdrawn as every feature of the claims is shown in the drawings.

Claims 1-5, 8-14 and 16 have been rejected under 35 U.S.C. 112, second paragraph as being indefinite. The Applicant respectfully disagrees, and the examiner is requested to withdraw the rejection. The test for definiteness under 35 U.S.C. §112, second paragraph is whether a person skilled in the art would understand the claim language in light of the specification and drawings. Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 1 USPQ2d 1081 (Fed. Cir. 1986). Definiteness of claim language must be analyzed, not in a vacuum, but in light of the content of the application disclosure (see MPEP 2173.02). There is nothing confusing or unclear about the language in Claim 1. In the first two lines, Claim 1 recites "Device for manipulating substrates (11) inside and outside an ultraclean workroom (15)". There is nothing confusing or unclear about this. Further, Claim 1 recites on line 3 "...with a storage room and a sluice device (17), the sluice device..., and (on line 8) with a first manipulating device (51) ..." The language in Claim 1 when read in its entirety is clear, and would reasonably appraise one skilled in the art as to the scope of what is claimed. This is especially so when reading the language in Claim 1 in view of the description and drawings in the instant application. It is noted, that the structure of the language in the claims reflects the translated nature of the application, and may not be in perfect grammatical form. However, the test for definiteness does not require that the claim have correct grammar, but merely that it be understandable to one skilled in the art when read in light of the specification and drawings. Claim 1 meets this requirement. It is further noted, that prior to the decision of the US Supreme Court in Festo Corporation V. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., Applicant's attorney would have made the change for the examiner, but now, after Festo, no changes will

be made under a 35 U.S.C. §112, second paragraph rejection unless clearly necessary beyond a preponderance of evidence. This is not the case in the present 35 U.S.C. §112, second paragraph rejection. The examiner is requested to reconsider his rejection.

The Examiner appears to question, in sect. 4a of the Action, whether the Applicant is presenting the Claims in some kind of "Jepson" form (i.e. wherein the Applicant is acknowledging prior art within the format of the claim itself). It is noted, that none of the claims pending in this application are "Jepson" type claims, and the Applicant is not making any kind of acknowledgment of prior art in the claims other than what can be legally construed in the claim preamble (i.e. Device for manipulating substrates inside and outside an ultraclean workroom). Though written in European form, neither Claim 1 nor any other claims are "Jepson" type claims and should not be construed as such.

With respect to the term "the boxes", adequate antecedent basis is provided by the term "a box" on line 7 in Claim 1. As stated in M.P.E.P. 2173.05(e), the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. Here it is clear that "a box" provides adequate basis for "a multiple number of the boxes".

The language in Claim 1 referring to "accommodated in row and/or column arrangement" is merely alternative language, and the mere use of alternative language does not per se render the claim indefinite. Rather, as has been noted before, the test for definiteness is merely whether the scope of a claim would be

reasonably ascertainable by those skilled in the art. The language in claim 1, "accommodated in row and/or column arrangement...", can be clearly understood to mean accommodated in row and column arrangement, or column arrangement... Here again, as noted above, the Applicant in view of Festo, will not make changes in response to 35 U.S.C. 112, Second paragraph rejections unless clearly necessary beyond a preponderance of evidence. Claim 1 is definite and the rejection should be withdrawn

Claim 3 recites that each locking unit has a sluice door. There is nothing confusing, vague or unclear about this language. Further, claim 3 recites that the sluice door is formed by a component of the box. The meaning of this language also very clear, and the language meets the definiteness criteria under 35 U.S.C. 112, second paragraph. (Sluice door is formed by box component 63, 67; see Figs. 1 and 3.) Claim 3 is definite and the rejection should be withdrawn.

Claim 9 has been amended to overcome the rejection. Claim 11 has also been amended to overcome the rejection.

Claims 1-5, 8, 11-14 and 16 have been rejected under 35 U.S.C. 102 as being anticipated by Iwai et al. (hereinafter Iwai). The Applicant respectfully disagrees.

Claim 1 recites that the storage area (of the device) is overhanging substantially the entire ultraclean workroom. Iwai does not anticipate the features recited in claim 1. In Figs. 11-12, Iwai discloses a process tube 101 that is accessed from a load lock chamber 108. The load lock chamber 108 and process tube 101 are separated by partition wall 154 from an input/output chamber 112. This partition area of the treatment

apparatus in Iwai, holding the process tube 101 and load lock chamber 108 and separated from the input/output chamber 112 by partition wall 154 is held under cleanroom conditions. The cleanroom partition in Iwai further includes a cassette extracting stage 117. As seen clearly in Fig. 11, the input/output chamber 112 (in which the cassette accommodating vessels 114 are stored) is located over only the cassette extracting stage 117 of the cleanroom partition. Thus, at best, the input/output chamber 112, and in particular the storage stage 116 of the input/output chamber, can be considered to be located over only a small part of the cleanroom partition from the whole or entire cleanroom, and not overhanging substantially the entire cleanroom partition. Claim 1, on the other hand, recites that the storage area is overhanging substantially the entire ultraclean workroom. Iwai fails to disclose the features recited in claim 1. Claims 1, 4, 6, 9-10, and 13-14 are patentable over the cited prior art and should be allowed.

Claim 2 recites that the sluice device has more than one locking units through which the substrate can be accessed. Iwai does not anticipate the features recited in claim 2. In Figs. 11-12, Iwai discloses that the cassette extracting stage has but one cassette inlet hole 155 that serves as an opening portion to allow the cassette to be extracted and moved into the clean room partition. By comparison, claim 2 calls for more than one locking units through which the cassette can be accessed. This is not disclosed in Iwai. Claims 2-3, 5, 8, and 11 are patentable over the cited prior art and should be allowed.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and

are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested.

The Examiner has made the Action final. The Applicant respectfully notes that making this Action final is premature and improper in this case. The earlier amendments made by the Applicant in response to the first Action, were made to accommodate the examiner as much as possible and overcome the rejection under 35 U.S.C. 112, Second paragraph. In the first Action, the Examiner did not raise any rejections based on prior art, though clearly, the features recited in the claims (and certainly in some of the claims) could be reasonably understood for a rejection based on prior art to be made if such a rejection was warranted. In addition, features brought to the claims by the Applicants previous amendment should reasonably have been expected to be claimed in view of the earlier rejection under 35 U.S.C. 112, second paragraph. M.P.E.P. 706.07(a) states that a second action on the merits should not be made final if it includes a rejection on prior art not of record of any claim amended to include limitations which should reasonably have been expected to be claimed. That is the case here. Further the Examiner's statement, that the amendment necessitated the new grounds of rejections in the last Action, is not correct, because clearly the amendments were not of such nature that prior to amendment no rejection based on prior art was deemed warranted but after amendment a rejection based on prior art was then deemed appropriate. Making this current Action final is prejudicial to the Applicant, not providing the Applicant with an opportunity to adequately address the only rejections based on the prior art of record which are being

raised for the first time only in this current Action. The finality of the last Action should be withdrawn.

Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



Janik Marcovici

Reg. No. 42,841

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512


4/13/04

Date

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JANIK MARCOVICI